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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/371,038	08/10/1999	LISA S. PURVIS	04529.81506	8784

7590 04/22/2003

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EXAMINER
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MITCHELL, MONICA J

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/371,038

Applicant(s)

PURVIS ET AL.

Examiner

Monica J. Mitchell

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

2. Claims 1-15 of this application conflict with claims 8, 11, 54, 57, 100 and 103 of Application No. 09/370,891. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of copending Application No. 09/370,891.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 8 of application no. 09/370,891 is drawn to the apparatus of claim 1, further comprising the store traverser, wherein the selector includes logic to select the selection policies as some of the applicable policies and the store traverser as one of the at least one traverser, the store traverser being capable of traversing a list of valid itineraries based on the selection policies and a job description and of looking for the itinerary to process the job, wherein claim 1 states that an apparatus to find an itinerary to process a job in a machine comprising: a selector (i) to select at least one traverser and (ii) to select applicable policies from a library based on a model of the machine wherein the applicable policies include at least one of configuration policies and selection policies, and wherein the at least one traverser includes at least one of (i) a model traverser and (ii) a store traverser.

Claim 1 of the present application is drawn to a scheduler for a machine comprising: a selector to select a traverser and to select policies from a library based on a model of the machine, and the traverser that is selected by the elector to look for a preferred itinerary.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 2-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 09/370,891.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 11 of application no. 09/370,891 is drawn to the apparatus wherein the store traverser includes: a first module to choose an itinerary from a group of itineraries, the group of itineraries being one of a sub-set of the itineraries and all of the itineraries in the list of valid itineraries; and itinerary validator to calculate an itinerary weight for the chosen itinerary for each of the selection policies; a second module to calculate a combined weight for the chosen itinerary based on a combination of all of the calculated itinerary weight corresponding to respective selection policies; and logic to repeatedly operate the first module and the itinerary validator and the second module for additional itineraries from the group of itineraries until an end condition is reached, the end condition being at least one of when a calculated combined weight for an itinerary exceeds a predetermined threshold, when a predetermined time has elapsed, when a combined weight for each of a predetermined number of itineraries has been calculated, and when a combined weight for each itinerary in the group of itineraries has been calculated.

Claim 2 of the present application is drawn to the scheduler wherein the traverser includes: a first module to choose itinerary; a second module to calculate a combined weight; and logic to repeatedly operate the first and second modules to choose additional itineraries from the group of itineraries from the group of itineraries and

Art Unit: 2622

calculate their combined weight until an end condition is reached. Claim 3 of the present application is drawn to the scheduler further comprising a third module to choose after the end condition is reached an itinerary that has a combined weight calculated by the second module that is greater than a combined weight of any other itinerary calculated by the second module. Claim 4 of the present application is drawn to the scheduler wherein: the first module chooses an itinerary from a group of itineraries, the group of itineraries being one of (i) a subset of the itineraries in a list of valid itineraries and (ii) all of the itineraries in the list of valid itineraries, and the second module includes (i) an itinerary validator to compute an itinerary weight for the chosen itinerary for each of the policies and (ii) a combined weight for the chosen itinerary. Claim 5 of the present application is drawn to the scheduler wherein the end condition includes at least one of when a calculated combined weight for an itinerary exceeds a predetermined threshold, when a predetermined time has elapsed, when a combined weight for each of a predetermined number of itineraries has been calculated, and when a combined weight for each itinerary in the group of itineraries has been calculated.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claim 6, dealing with the method of claim 1, is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 54 of copending Application No. 09/370,891. Rejection is the same as stated in paragraph 4 above.

7. Claims 7-10, dealing with the method of claims 2-5, is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 57 of copending Application No. 09/370,891. Rejection is the same as stated in paragraph 5 above.

8. Claim 11, dealing with the computer readable media of claim 1, is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 100 of copending Application No. 09/370,891. Rejection is the same as stated in paragraph 4 above.

9. Claim 12-15, dealing with the method of claim 2-5, is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 103 of copending Application No. 09/370,891. Rejection is the same as stated in paragraph 5 above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica J. Mitchell whose telephone number is 703-306-3430. The examiner can normally be reached on Mon.-Fri., 7:30 a.m. to 4:30 p.m.; Alt. Fri. Off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9313 for regular communications and 703-872-9313 for After Final communications.

Application/Control Number: 09/371,038  
Art Unit: 2622

Page 7

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.

mjm  
April 17, 2003

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600